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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,800

01/17/2006

Richard Farrar

1781-0017

5890

28078 7590 03/16/2010

MAGINOT, MOORE & BECK, LLP

CHASE TOWER

111 MONUMENT CIRCLE

SUITE 3250

INDIANAPOLIS, IN 46204

EXAMINER

WOODALL, NICHOLAS W

ART UNIT

PAPER NUMBER

3775

MAIL DATE

DELIVERY MODE

03/16/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/524,800	Applicant(s) FARRAR ET AL.	
	Examiner Nicholas Woodall	Art Unit 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 May 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. This action is in response to applicant's amendment received on January 4th, 2010.

Drawings

2. The drawings were received on 05/20/2009. These drawings are not acceptable because new limitations were added, i.e. the addition of a cutting blade, that are not supported by the disclosure as originally filed.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims have been amended to require the invention to further include a surgical tool for cutting, which is not supported by the disclosure as originally filed. The applicant directs the examiner to paragraphs 8, 9, 20, and 26 and original claims 6 and 7 for support of the newly added limitations (see page 8 of the applicant's arguments filed on January 4th, 2010). The examiner would like to note that the paragraphs of the specification as originally filed as well as claims 6 and 7

Art Unit: 3775

as originally filed passively state that the device can be used with a surgical tool, such as a saw blade or a drill bit. For example, paragraph 8 states "...the structural feature can comprise a guide surface which **can be engaged by a cutting tool such as a blade...**" (emphasis added by the examiner). Also, paragraph 9 states "...the structural feature can comprise an opening **in which a drill bit can be** inserted "(emphasis added by the examiner). Furthermore, page 1 line 1 of the specification states "This invention relates to a guide block which can be used in surgery, especially orthopedic surgery, to locate a surgical tool." The disclosure as originally filed never positively recites the invention including the surgical tools. Stating that the guide block is capable of being used with certain surgical tools is not disclosure of the invention including the surgical tools. Therefore, the disclosure as originally filed does not support the guide block in combination with the cutting tools making the limitations new matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 3-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hauri (WIPO Publication WO00/00093).

Hauri discloses a device comprising a guide block, at least one position monitor (17f) for tracking the location of the position indicator to position the guide part relative to a reference point, a signal generator (the computer) connected to the drives to

generate positioning signals that are transmitted to the drives to cause movement of the guide part relative to fixation parts of the guide block relative to a reference point, and a surgical tool (12), i.e. a saw blade, having a cutting structure that engages the tool engagement surface of the guide part during use of the surgical tool (see Figure 12). The guide block comprises fixation parts (3, 10a, 10c, etc.) attached to the patient's tissue, a guide part (11) mounted in relation to the fixation parts having a first tool engagement surface (11a) to engage a bone saw, a second tool engagement surface (11b) to engage a drill, at least two drives (5v and 10f) to adjust the position of the guide part relative to the fixation parts in at least two degrees of freedom, wherein the drives include adjusting means, i.e. knobs, accessible outside the housing (see Figure 10), and at least one position indicator (10g) fixed to the fixation parts at a location related to the location of the guide part when attached to the fixation parts (see column 10 lines 26-37). The guide block further includes a housing (10e) in which the drives are located, The guide block further includes connector shafts (for example 10c) that extend from the fixation parts to the guide part, wherein the connector shafts are moved relative to the fixation parts by the drives to adjust the location of the guide part. The fixation part further includes a plurality of openings (for example 3b, 3c, and 3d) that receive bone screws (4) to fix the device the patient's tissue.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3775

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 4-6, 8, and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeOrio (U.S. Patent 5,681,316) in view of Hauri (WO00/00093).

DeOrio discloses a device comprising a guide block. The guide block comprises fixation parts (12, 16, 20, etc.) attached to the patient's tissue, a guide part (26 and 60) mounted in relation to the fixation parts having a tool engagement surface (97) to engage a bone saw, at least three drives (34, 38, 40, and 42) to adjust the position of the guide part relative to the fixation parts in at least three degrees of freedom, wherein the drives include adjusting means, i.e. knobs,. The guide block further includes connector shafts (for example 14 and 58) that extend from the fixation parts to the guide part, wherein the connector shafts are moved relative to the fixation parts by the drives to adjust the location of the guide part. The fixation part further includes an opening (36) that receive a fastener (28) to fix the device the patient's tissue. DeOrio further discloses at least one drive (42) includes a threaded shaft (88) on the guide part, the examiner is interpreting element 60 as part of the guide part and the treaded shaft of the drive is located on the guide part, that is received by a threaded bore (92) on the fixation part, wherein the drive adjusts the medio-lateral angle of the guide part (see column 3 lines 39-42). DeOrio fails to disclose the device further comprising a computer assistance mechanism and a cutting tool. Hauri teaches a device comprising a guide block having drives (5f and 10v), a surgical tool, i.e. a bone saw, and a computer assistance mechanism, wherein the computer assistance includes at least one position monitor (17f), at least one position indicator (10g) attached to the guide block, a signal generator

Art Unit: 3775

(a computer) connected to motors that operate the drives via a flexible shaft (17a) that imparts rotation motion to the drives from a remote location in order to allow the surgeon to cut the bone of a patient and to allow the surgeon to perform the surgical procedure in an extremely precise manner (column 1 lines 4-7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of DeOrio further comprising a surgical tool and a computer assistance mechanism in view of Hauri in order to allow the surgeon to cut the bone of a patient and to allow the surgeon to perform the surgical procedure in an extremely precise manner.

Response to Arguments

9. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection. The applicant has amended the claims to include a limitation requiring the position indicator being supported and fixed relative to the guide part. The examiner has considered the amendment and provided new grounds of rejection using the same references as discussed above. The examiner is interpreting element 10g as the position indicator based on the disclosure of column 10 lines 26-37 that discloses how element 10g is used to determine the position of the femoral condyle relative to the system and element 10g is directly supported and fixed to the guide part. The examiner has provided new grounds of rejection as necessitated by the amendment making this office action **FINAL**.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3775

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/
Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art
Unit 3775